

**Confidential Serial No: 10/433,150**  
**Response to Official Action of July 28, 2003**

**RESPONSE TO OBJECTIONS AND REJECTIONS**

In response to the Official Actions dated April 4, 2005 and September 13, 2005 , applicant has amended claims 13, 15 and 19 without prejudice or disclaimer. The Official Action indicates that Claims 2-6 and 8-11 are allowable, accordingly, applicant will not address these claims in the response.

On page 2 of the Official Action, the Examiner objected to Claims 15 and 19 for having minor informalities. Applicant has amended these claims to address these informalities as kindly indicated by the Examiner. Accordingly, these objections are moot and the objections may be respectfully withdrawn.

On pages 2 and 3 of the Official Action, the Examiner rejected to Claims- 13 and 15-17 under 35 U.S.C., first paragraph, as failing to comply with the enablement requirement. Applicant respectfully disagrees with this rejection. The Examiner claims the range of "25 mm to above" is indefinite. However, these type of claim language is commonly used in numerous issued patent applications and clearly states what the metes and bounds of applicant's invention is. Any range at least 25 mm or greater would directly fall into the claimed range. See MPEP 2173.05(c).

Furthermore, the Examiner rejected claims 1-19 under 35 U.S.C. second paragraph, as being indefinite for failing to particularly point out and distinctly claims the subject matter which applicant regards as the invention. Applicants agree in part and disagree in part. The Examiner indicated that Claim 13 is definite because it includes a claim range not disclosed in the specification.

Applicant has amended the claim to conform to the description in the specification, as kindly indicated by the Examiner in the Official Action. It should be noted that this was a typing error and the amendments were not done to overcome prior art references, and therefore should not be subject to any file history estoppel.

Regarding the rejection with regards to the term "about" used in the claims, applicant respectfully disagrees with the Official Action. The term "about" is also commonly used in patent applications, and is even described in the MPEP 2173.05(b) as being a term which is definite.

Claims 1, 7 and 12 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Herman '716 in view of Lininger '228. Furthermore, Claims 1, 7 and 12 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Herman '716 in view of Taber '102. Applicant respectfully disagrees with the rejection for the reasons stated below.

Applicant believes the cited references fail to disclose or render obvious the claimed invention. Accordingly, applicant respectfully requests that the rejections be withdrawn and the claims be placed in condition for allowance.

On September 2, 2005 applicant, applicant's representative, Examiner Talbott and Primary Examiner Boyer Ashley conducted a phone interview discussing the differences between the cited references and the claimed invention. Some of the argument presented below were covered in this phone interview.

Applicant's invention includes a novel handpiece apparatus used for cutting tools which is able to accept all standard shank sizes from at least 1/16"

to  $\frac{1}{4}$  inch. Furthermore, the present invention provides for a shrouded/guarded adjustable 3-jaw key type chuck having an effective capacity of 0 – 6.35 mm.

Applicants believe that the Official Action attempts to combine several references in order to come up with the claimed invention. Applicant believes not only do none of the references show a motivation for such a combination, but also these references do not specifically deal with the same type of art and have contrasting uses. Furthermore, the deficiencies in the references are due to the novelty in the claimed invention.

Herman discloses a ball bearing handpiece used for tools. First, Herman fails to disclose a shrouded chuck as recited in the independent claims. Second, the handpiece disclosed in the Herman patent does not relate to the Jacob style chuck as is disclosed in the present invention. Furthermore, there are no dimensions given in the Herman patent which one skilled in the art could assess the similarities in their respective measurements. It appears evident the Herman patent fails to appreciate or understand the importance of the dimensioning of the claimed invention and the ability of a handpiece to accept all standard shank sizes from at least  $1/16$ " to  $\frac{1}{4}$  inch. The Herman patent has many deficiencies. Not only does Herman fail to disclose the claimed limitations cited in the claims, but also the other cited references also have the same deficiencies.

Liniger relates to a holder for "electrodes, such as consumable welding rod electrodes used in electric welding, by which an electrode may be gripped and manipulated during a welding operation". See Col 1, lines 1-5 in Liniger.

The device disclosed in Liniger does not relate to the present invention. Liniger

does not disclose a holder for cutting tool device, but instead is a holder for electrode rods. Liniger also fails to disclose a chuck for a rotating device as is recited in applicant's claimed invention.

Taber relates to a key and retainer device for a chuck assembly. Taber relates more to a collar that fits over a nose and locking cylinder of a chuck of the drilling machine. Taber is a device which holds the chuck stationary and **does not rotate**, as is required by the claimed invention. The claimed invention requires that the chuck assembly is "rotatable connected to the interior of the shrouded wall portion." Taber fails to disclose or render obvious such a feature.

As discussed in the personal interview with the Examiner and Primary Examiner, applicant believes the cited reference do not anticipate or render obvious the claimed invention. Therefore, applicant believes that the claims are in a condition for allowance.

Should the Examiner have any questions, please contact Rouz Tabaddor, Esq. at (202) 489-7849 or at [rouz@tabaddorlaw.com](mailto:rouz@tabaddorlaw.com)

Respectfully submitted,

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